

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 1, 6, 11, 16, 18, 20, 22, 24, 26, 28, 30 and 32 will have been amended and submitted for reconsideration by the Examiner. Claims 2, 5, 7, 10, 12, 15, 17, 19, 21, 23, 25, 27, 29, 31, and 33 will have been canceled without prejudice or disclaimer. In view of the above, Applicant respectfully requests reconsideration of the outstanding rejection of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided.

Turning to the merits of the action, the Examiner has rejected claims 1-33 under 35 U.S.C. § 103(a) as being unpatentable over LEE et al. (U.S. Patent No. 5,742,769) in view of WEBER et al. (U.S. Patent No. 5,878,230).

However, Applicant respectfully traverses the above rejection.

As noted above, Applicant has amended claims 1, 6, 11, 16, 18, 20, 22, 24, 26, 28, 30 and 32 for consideration by the Examiner, and has canceled claims 2, 5, 7, 10, 12, 15, 17, 19, 21, 23, 25, 27, 29, 31, and 33 without prejudice or disclaimer and has incorporated the recitations thereof into the respective independent claims. Applicant respectfully traverses the above rejection based on the pending claims and will discuss the rejection with respect to the pending claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter recited in the rejected claims, but do not raise any new issues requiring further search or consideration.

As noted above, by the present Response, Applicant has resubmitted claims 1, 6, 11, 16, 18, 20, 22, 24, 26, 28, 30 and 32 for consideration by the Examiner. These claims, as noted above, now recite a scanner, a start button and a controller that, in response to the start button being operated by the user of the image data communication apparatus, converts the image data scanned by the scanner into a format for e-mail transmission. Adequate and sufficient support for these features is found in the original disclosure at least in paragraph [0021] of the specification.

Applicant's claims 1, 3-4, 6, 8-9, 11, 13-14, 16, 18, and 20 generally relate to an image data communication apparatus connected to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network. The e-mail includes a mail from command and a mail message. The image data communication apparatus includes a scanner which scans the image data. The image data communication apparatus includes a memory which stores an e-mail address of at least one user. The memory is within the image data communication apparatus.

The image data communication apparatus includes a panel which selects the e-mail address of at least one user stored in the memory and that includes a start button. The image data communication includes a controller which, in response to the start button being operated by the user of the image data communication apparatus, controls the scanner to scan the image data and to convert the image data scanned by the scanner into a format for e-mail transmission. The controller sets the e-mail address of the user, selected by the panel into the mail message of the e-mail to which the image data is attached. The mail address of the user is distinct from an e-mail address of the image data communication apparatus. Then, the e-mail address of the user, set into

the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus. Thus, reply is returned to the e-mail address of the user, and not to the image data communication apparatus. Claims 22, 24, 26, 28, 30, and 32 recite related methods.

In direct contrast, LEE et al. relates to a system in which individual users 10 can access the directory service 24 to obtain directory information about a very large number of people and businesses (col. 2, lines 16-33). The users 10 can register basic directory information, i.e., names, addresses, and telephone numbers into the storage 30 of the directory service 24 (col. 2, lines 34-43, col. 4, lines 63-67, and col. 5, lines 1-16). The users 10 can search in the directory service 24 for the directory information of other users 10 (col. 2, lines 43-65, col. 6, lines 48-67 and col. 7, lines 1-12).

However, LEE et al. does not disclose an image data communication apparatus which sets the mail address of the user selected by the panel into the mail message of the e-mail to which the image data is attached, the mail address of the user being distinct from a mail address of the image data communication apparatus, whereby the mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus, the reply being returned to the mail address of the user, and not being returned to the image data communication apparatus.

Rather, in LEE et al., the sender sets a sender's e-mail address into a "Reply-to" field; therefore, a reply to a sending e-mail is returned to the sender that has transmitted the sending e-mail (col. 7, lines 26-63). In other words, LEE et al. merely disclose a conventional reply mail.

On the other hand, and in stark contrast to LEE et al., the present invention recites an image data communication apparatus which sets the e-mail address of the user selected by the panel into the mail message of the e-mail to which the image data is attached. The e-mail address of the user is distinct from an e-mail address of the image data communication apparatus. Thus, in the present invention, the e-mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus. As a result, the reply is returned to the mail address of the user, but not to the image data communication apparatus.

Further, LEE et al. does not disclose an image data communication apparatus which has a scanner that scans image data and has a panel that includes a start button. LEE et al. also does not disclose an image data communication which, when the start button is pushed by the user of the image data communication apparatus, controls the scanner to scan the image data and converts the image data scanned by the scanner into a format for e-mail transmission. Rather, LEE et al. merely disclose individual users 10, servers 16 and 18, Internet providers 20 and 26, and the directory service 24. Thus, LEE et al. does not even disclose a device which has a scanner that scans image data and has a panel that includes a start button and which, in response to the start button being operated by the user of the image data communication apparatus, controls the scanner to scan the image data and to convert the image data scanned by the scanner into a format for e-mail transmission. In other words, LEE et al. merely relates to e-mail transmission by a personal computer, but does not disclose

or even suggest e-mail transmission by an image data communication apparatus which has a scanner that scans image data and has a panel that includes a start button.

As noted above, LEE et al. deals with nothing more than conventional e-mail reply procedures. In this regard, in addition to not including a scanner which is recited in the pending claims and in addition to not controlling the scanner in a manner recited in Applicant's claims, Applicant further notes that LEE et al. does not set an e-mail address of a user selected by a panel from a memory into a mail message of an e-mail to which image data is attached. All LEE et al. provides for is a mechanism that copies a previously entered sender's e-mail address into a from field and a reply field. This is nothing more than conventional e-mail technology. However, LEE et al. does not in any way provide at least a controller that is configured to set an e-mail address of a user that is selected by a panel into a mail message of an e-mail to which image data is attached with the e-mail address of the user being distinct from an e-mail address of the image data communication apparatus. Nor does LEE et al. disclose that the e-mail address of the user that is set into the mail message of the e-mail can be used as a destination for reply that is sent from the receiving apparatus the reply being returned to the e-mail address of the user but not returned to the image data communication apparatus. In LEE et al., as can clearly be seen in column 7, lines 26-41, the sender (i.e., "From:") is the same as the reply. Accordingly, LEE et al. further fails to comply with the explicit recitation of Applicant's claims that the e-mail address of the user which is used as a destination for reply to the e-mail be distinct from the e-mail address of the image data communication apparatus which as recited in the claims is configured to transmit image data to a receiving apparatus via the network. For these additional

reasons, it is respectfully submitted that LEE et al. is an inappropriate basis for the rejection of any of the claims in the pending application.

Thus, the pending claims are clearly distinct from LEE et al.

Therefore, it is respectfully submitted that the features recited in Applicant's resubmitted claims are not disclosed in LEE et al. cited by the Examiner.

WEBER et al. discloses a system in which the sender may want to direct responses to the e-mail message to a variety of third-party recipients (column 3, lines 21-31) and in which, when third-party addressing (i.e., reply override) is indicated, the interexchange document profile IDP places the addresses specified by the original sender as the primary address field (column 5, lines 13-29).

However, WEBER et al. does not disclose an image data communication apparatus which has a scanner that scans image data and has a panel that includes a start button. WEBER et al. also does not disclose an image data communication which, in response to the start button being operated by the user of the image data communication apparatus, controls the scanner to scan the image data and converts the image data scanned by the scanner into a format for e-mail transmission. Rather, WEBER et al. merely discloses individual computers 12 and 30, printer/output devices 16, storage devices 14, and the gateway server 28. Thus, WEBER et al. does not even a device which has a scanner that scans image data and has a panel that includes a start button and which, in response to the start button being operated by the user of the image data communication apparatus, controls the scanner to scan the image data and converts the image data scanned by the scanner into a format for e-mail transmission. In other words, WEBER et al. merely relates to e-mail transmission

by a personal computer and downstream routing of an e-mail message. However, WEBER et al. does not disclose or even suggest e-mail transmission by an image data communication apparatus which has a scanner that scans image data and has a panel that includes a start button.

On the other hand, the present invention recites an image data communication apparatus which has a scanner that scans image data and has a panel that includes a start button and which, in response to the start button being operated by the user of the image data communication apparatus, controls the scanner to scan the image data and converts the image data scanned by the scanner into a format for e-mail transmission.

WEBER et al. also does not relate to reply messages as that term is utilized in the present application. WEBER et al. requires the setting up of reply addresses as set forth in step 56 of Fig. 5. However, WEBER et al. contains no teaching regarding setting of an e-mail address of a user, selected by the panel, into the mail message of the e-mail to which image data is attached. Accordingly, for this additional reason, WEBER et al. is an inappropriate basis for the rejection of any of the pending claims herein.

Thus, the pending claims are clearly distinguished over WEBER et al.

Therefore, it is respectfully submitted that the features recited in Applicant's resubmitted claims are not taught or disclosed in WEBER et al. cited by the Examiner.

Claims 1, 2-4, 6, 8-9, 11, 13-14, 16, 18, 20, 22, 24, 26, 28, 30, and 32 are also submitted to be patentable over the Examiner's proposed combination. In particular, since neither LEE et al. nor WEBER et al. disclose the features recited in Applicant's

claims 1, 2-4, 6, 8-9, 11, 13-14, 16, 18, 20, 22, 24, 26, 28, 30, and 32, the pending claims are clearly distinguished over the combination of LEE et al. and WEBER et al.

Additionally, Applicant notes that the Examiner has not set forth any proper motivation for the modification of the teachings of LEE et al. by the teachings of WEBER et al. In particular, both LEE et al. and WEBER et al. merely relate to e-mail transmission by a personal computer. Thus, both LEE et al. and WEBER et al. do not disclose or even suggest e-mail transmission by an image data communication apparatus which has a scanner that scans image data and has a panel that includes a start button and which, in response to the start button being operated by the user of the image data communication apparatus, controls the scanner to scan the image data and converts the image data scanned by the scanner into a format for e-mail transmission. Therefore, Applicant submits that even if one attempted to combine the teachings of LEE et al. and WEBER et al. in the manner suggested by the Examiner, one would fail to arrive at the instant invention, as defined by pending claims 1, 2-4, 6, 8-9, 11, 13-14, 16, 18, 20, 22, 24, 26, 28, 30, and 32, since such a combination would fail to provide an image data communication apparatus which has a scanner that scans image data and has a panel that includes a start button and which, in response to the start button being operated by the user of the image data communication apparatus, controls the scanner to scan the image data and converts the image data scanned by the scanner into a format for e-mail transmission.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application, in due course.

P24494.A06

Although the status of the application is after final rejection, Applicant submits that entry of the amendment is proper under 37 C.F.R. § 1.116. In particular, no new issues are being presented and no new claims are being submitted. It is believed that the Examiner has searched and considered the claim limitation now recited in the independent claims as they were previously recited in the now canceled dependent claims. The Examiner is respectfully requested to exercise his discretion in this regard.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has canceled some rejected claims without prejudice or disclaimer, and has amended other rejected claims for reconsideration by the Examiner. With respect to the rejected claims, Applicant has pointed out the features thereof and has contrasted the features of the rejected claims with the disclosure of the references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.


The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should an extension of time be necessary to maintain the pendency of this application, including any extensions of time required to place the application in condition for allowance by an Examiner's Amendment, the Commissioner is hereby authorized to charge any additional fee to Deposit Account No. 19-0089.

P24494.A06

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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